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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,414	08/25/2003	John P. Vukos	KCC 4974 (K-C 18,840)	2803
321	7590	12/21/2005	EXAMINER	
SENNIGER POWERS ONE METROPOLITAN SQUARE 16TH FLOOR ST LOUIS, MO 63102			BOGART, MICHAEL G	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TWA

Office Action Summary

Application No.

10/647,414

Applicant(s)

VUKOS ET AL.

Examiner

Michael G. Bogart

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 26-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 16-18 and 20-25 is/are rejected.
- 7) ☒ Claim(s) 14, 15 and 19 is/are objected to.
- 8) ☒ Claim(s) 26-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1-3-04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-25, drawn to an absorbent article comprising four microlayered films, classified in class 604, subclass 385.378.
- II. Claims 26-31, drawn to an absorbent article comprising plural strips of micro layer material, classified in class 604, subclass 385.01.
- III. Claims 32-39, drawn to a method of making an absorbent article comprising coextrusion to form microlayers, classified in class 264, subclass 173.12.

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require four microlayers having different properties. The subcombination has separate utility such as it may be used absent any side strips.

Inventions I, II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the

instant case the apparatus does not require the steps of activating the microlayers so that they form their claimed different functions, or the steps of sequentially assembling the layers.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Richard Bridge on 30 November 2005 and 12 December 2005, a provisional election was made with traverse to prosecute the invention of I, claims 1-25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections – 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is partial defined by its absorbent capacity according to a performance test.

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired

characteristics; thus, expression "a liquefiable substance having a liquefaction temperature from about 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended. *Ex parte Slob* (Bd. Pat. App. & Int 1968) 157 USPQ 172; *Austenal Laboratories, Incorporated v. Nobilium Processing Company of Chicago et al.*, 115 USPQ 44 (D.C. N. Ill. 1957).

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 8 and 20-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Topolkaraev *et al.* (US 6,071,450 A)(hereinafter "Topolkaraev").

Regarding claims 1 and 22, Topolkaraev teaches an absorbent article, comprising a unitary system of microlayered film constructed and arranged for performing the multiple functions of such absorbent article, said system comprising;

Art Unit: 3761

at least one first microlayer film region (120) having a liquid intake function,
at least one second microlayer film region having a liquid uptake and distribution function,
at least one third microlayer film region having a liquid retention function, and
at least one fourth microlayer film region (130) having a liquid barrier function (col. 30, line 52-col. 31, line 52).

Regarding the second and third film regions, each of film regions (120) and (130) is made up of laminates of component films, meaning that there are many film layers from the top to bottom surfaces of the overall film. (col. 5, lines 4-20). The intermediate films are each capable of performing a liquid intake function and a liquid retention function, such that the upper layers will accept and spread out liquid inflow so that it flows downward to the area above the barrier (130) where it is stop, and the liquid is retained there.

Regarding claims 2-6, these claims are defined by the various layers that are co-extruded during manufacturing. This makes each of claims 2-6 product by process claim. Product-by-process claims are not limited by the manipulations of the recited steps, only the structure implied by the steps. Topolkaraev teaches that a combination of layers are coextruded and then extruded through a series of multiplying elements where they split and coextruded again, the process being repeated multiple times until the final product is complete, with all of the layers being coextruded to each other simultaneously (col. 10, lines 47-co. 11, line 11). The end product is physically the same as that claimed by claims 2-6.

Regarding claim 8, Topolkaraev teaches that the micro layer film regions include at least two microlayers, forming a laminate (col. 4, lines 12-29).

Regarding claims 20 and 21, Topolkaraev teaches a personal care product, such as a diaper (100).

Regarding claims 23 and 24, Topolkaraev teaches the retention region is formed entirely of microlayered film. As interpreted herein, layer (120) contains many layers, the top third of which can perform a liquid intake function, the middle third can perform a liquid uptake and distribution function, the bottom third of which can perform a retention function, as some liquid will be retained over time. Absorbent layer (140) is regarded as a separate element from the retention region of sheet (120).

Regarding claim 25, Topolkaraev teaches that at least one region (140) is free of micro layer film (col. 31, lines 15-30).

Claims 1-13 rejected under 35 U.S.C. § 102(e) as being anticipated by anticipated by Topolkaraev (US 2004/0091677 A1)(hereinafter “’677”)

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, ‘677 teaches a film comprising many layers. The top layer can receive and intake liquids. Regarding the second and third film regions, each of the film regions is made up of laminates of component films, meaning that there are many film layers from the top to bottom surfaces of the overall film. The intermediate films are each capable of performing

Art Unit: 3761

a liquid intake function and a liquid retention function, such that the upper layers will accept and spread out liquid inflow so that it flows downward to the area above the lowest layer. Some or all of the layers contribute to the overall film's ability to function as a barrier to liquid (§'s 0008, 0014 and 0017)(fig. 1).

Regarding claims 2-6, these claims are defined by the various layers that are co-extruded during manufacturing. This makes each of claims 2-6 and product by process claim. Product-by-process claims are not limited by the manipulations of the recited steps, only the structure implied by the steps. '677 teaches that the many layers are coextruded together to produce the end product film (§ 0022). The end product is physically the same as that claimed by claims 2-6, as all layers have been extruded together.

Regarding claim 8, '677 teaches many layers, preferably 16-60. A film with 16 microlayers may be divided into 4 film regions each comprising a laminate of 4 microlayers (§ 0039).

Regarding claim 9, '677 teaches that the laminate comprises a thermoplastic melt extendable elastomer microlayer and a melt extendable non-elastic polymer microlayer (§'s 0040-0042 and 0049).

Regarding claim 10, '677 teaches that the laminate teaches that the laminate includes a multiplicity of alternating elastomer and non-elastic polymer microlayers (§'s 0042, 0049 and 0097).

Regarding claims 11-13, '677 teaches that the laminate is stretched after coextrusion to form corrugations and microchannels (§'s 0037 and 0042). As interpreted herein, microchannels are viewed as small channels, no specific dimension component is read into this

term. Viewing the overall disclosure of the reference, as best understood by the examiner all or essentially all of the layers may have small channels.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 18 are rejected under 35 U.S.C. § 103(a) as being obvious over Topolkaraev.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

Topolkaraev teaches an open area in the top layer in the form of apertures.

The reference does not teach the specific size of the open area, the density of the second micro layer or the claimed absorbent capacity.

Further regarding the rejection of claim 7 under 35 USC § 103, generally, differences in test characteristics will not support the patentability of subject matter encompassed by the prior

art unless there is evidence indicating such test characteristic is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Regarding claim 7, the benefits of increasing absorbent capacity would have been known prior to applying a test, making these values result-effective variables. One of ordinary skill in the art would have recognized that increasing absorbent capacity allows the final product to hold more liquid in use. MPEP § 2144.04.

Regarding claim 18, the examiner takes official notice of the fact that superabsorbents are widely used in many different types of absorbent articles.

Regarding the difference in relative dimensions and density, *see Gardner*, below.

Claims 16 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over ‘677.

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which

Art Unit: 3761

corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. § 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

‘677 does not teach the relative sizes of the channels from one film region to another.

Mere changes in the relative sizes of various elements alone are not sufficient to patentably distinguish a claimed invention from the prior art. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

Allowable Subject Matter

Claims 14, 15 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The art of record does not teach, in addition to the structural features discussed in the rejection under ‘677, *supra*, a microlayered film having layers with corrugations combined with

layers that are free of such corrugations or an elastic polymer, a non-elastic polymer and a super absorbent coextruded together.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Bogart
13 December 2005

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER
